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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,369	06/05/2001	Kengo Ochi	2309/0J434	7467

7590 08/28/2002

DARBY & DARBY P.C.
805 Third Avenue
New York, NY 10022

EXAMINER
SMITH, KIMBERLY S

ART UNIT	PAPER NUMBER
3644	

DATE MAILED: 08/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/875,369	OCHI ET AL.	
	Examiner	Art Unit	
	Kimberly S Smith	3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 August 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 June 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 08/07/02 have been fully considered but they are not persuasive. Regarding the rejection under 35 U.S.C. 112 1st paragraph: it is first noted that an Appendix A with the results of a search done by the applicant has not been submitted as stated in paper 5. However, a search was conducted prior to the first action in which the term "alpha starch" was searched. While a number of patents do contain the terminology "alpha-starch", this is not considered to be an enabling definition as to the invention of the applicant. The terminology "alpha-starch" appears to be a known term as applied to the Japanese language as an overwhelming majority of the patents listed were either issued through the Japanese Patent Office or are continuations of Japanese issued documents. As the term "alpha-starch" has not been listed within a chemical dictionary to which ones of ordinary skill in the art would have access to, the term "alpha-starch" is considered to be non-enabling. It is unclear as to whether the "alpha" is in reference to the position on the chemical chain or as to what starches the term is to encompass. It is suggested that the applicant clearly define what the term "alpha-starch" is to encompass to obviate this rejection. As it is unclear as to the scope of which the term "alpha-starch" is to encompass, the starch as disclosed in the prior art references are considered to fall within the scope of an alpha starch until a clarification as for what the terminology encompasses has been provided.

2. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., that the shape and the production method of Chickazara are different than the applicant's invention) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The rejections to claims 1-9 are maintained.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The use of the term α-starch within the claims and specification is noted. However, the term α-starch does not appear to be an art recognized term (see pages from *The Condensed Chemical Dictionary* regarding starches). As the applicant has not stated in general terminology what an α-starch is considered to be and what materials the use of this term includes or excludes, the specification is therefore considered to be non-enabling for one skilled in the art.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 5 and 7-9 is rejected under 35 U.S.C. 102(b) as being anticipated by Sasahara, JP 11-032608.

Sasahara discloses an animal excretion-treating material comprising particles having a core layer of fibers and a skin layer containing starch and fibers (paragraph 0010); wherein the fibers in the core layer and skin layer are those of pulp; wherein the bulk density falls between 0.1 and 0.5 (paragraph 0026); wherein the particle has a diameter between 2 and 20 mm (paragraph 0009).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasahara.

Sasahara discloses the invention substantially as claimed. However, Sasahara does not positively discloses that the skin layer fibers have a length between .02 to 1 mm, that the particle size of the starch in the skin layer is at most .25mm or that the skin layer has a starch to fiber ration between 20 to 80 and 80 to 20. It would have been obvious to one having ordinary skill in the art at the time the invention was made to find the optimal

values of the fiber length and the particle size, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasahara in view of Chikazawa, US Patent 5,209,185.

Sasahara discloses the invention substantially as claimed. However, Sasahara does not disclose the starch being tapioca. Chikazawa teaches within the same field of endeavor the use of tapioca as a starch in an artificial litter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use tapioca as the starch disclosed by Sasahara, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ito, US Patent 5,823,139.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly S Smith whose telephone number is 703-308-8515. The examiner can normally be reached on Monday thru Friday 10:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles T Jordan can be reached on 703-306-4159. The fax phone numbers for the organization where this application or proceeding is assigned are 703-306-4196 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

Charles T. Jordan
CHARLES T. JORDAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

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August 21, 2002